

REMARKS

In the office action mailed August 22, 2003, Claims 1-74 were pending in the present application. Of these, Claim 74 has been withdrawn from consideration by Applicant pursuant to an oral election made during a telephone conversation with the Examiner on March 12, 2003. Accordingly, Claims 1-73 remain pending for consideration in the present patent application.

Of Claims 1-73, the Examiner has objected to Claims 21-22 and 42-43 because the word "dye" should be spelled "die". Additionally, Claims 8-10 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Examiner alleges that the phrase "the nucleation enhancer" lacks antecedent basis. Further, Claims 1-73 were provisionally rejected under the judicially created doctrine of double patenting in view of Claims 1-19 and 55-61 of copending patent application serial no. 09/687,444. The Examiner has also objected to the title of the present patent application, alleging that it is not sufficiently descriptive of the present invention. Finally, the Examiner has discovered that Claims 35-75 were misnumbered as Claim 34 was inadvertently left out, and has therefore renumbered Claims 35-75 to be 34-74 in accordance with Rule 126.

By the present amendment, the Title of the application has been amended from "Cast diamond tools and formation thereof by chemical vapor deposition" to read "Methods of making diamond tools using reverse casting of chemical vapor deposition". Applicant submits that such amendment is sufficiently descriptive of the present invention and is therefore proper. Additionally, Claims 21-22 and 42-43 have been amended to provide the correct spelling of the word "die". Further, Claims 8-10 have been amended to add the word "layer" following the words "nucleation

enhancer”. Finally, Claims 35-49, 51-58, 61-65, and 68-72 have been amended to reflect a proper claim dependency in view of the Examiner’s renumbering of the claims.

In addition to the above recited claim amendments, Applicant submits herewith a Terminal Disclaimer. As indicated in the outstanding office action, a properly filed terminal disclaimer is sufficient to overcome the double patenting rejection of Claims 1-73.

In view of the foregoing amendments and the terminal disclaimer filed herewith, Applicant respectfully submits that all of the rejections of Claims 1-73 posed by the Examiner are moot, and that such claims are in condition for allowance. Accordingly, entry of this Amendment and expedited allowance of the claims is respectfully requested.

CONCLUSION

Applicant believes that presently pending claims 1-73 present allowable subject matter and allowance is respectfully requested. If any impediment to the entry of this Amendment allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone either Mr. David Osborne, or in his absence, the undersigned attorney at (801) 566-6633, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 20-0100.

Dated this 24 day of November, 2003.

Respectfully submitted,

THORPE, NORTH & WESTERN, LLP



M. Wayne Western
Reg. No. 22,788
8180 South 700 East, Suite 200
Sandy, UT 84070
Telephone: (801) 566-6633
Facsimile: (801) 566-0750